



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/632,298	04/12/96	MOHSEN	A M-1007US

LM71/1108

ALAN H MACPHERSON
SKJERVEN MORRILL MACPHERSON FRANKLIN
& FRIEL
25 METRO DRIVE SUITE 700
SAN JOSE CA 95110

EXAMINER

JONES, H

ART UNIT

2763

PAPER NUMBER

23

DATE MAILED: 11/08/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/632,298

Applicant(s)
Mohsen

Examiner
Hugh Jones

Group Art Unit
2763



☒ Responsive to communication(s) filed on Sep 28, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 20-28, 37-39, 42, 50-52, and 72-77 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 20-28, 37-39, 42, 50-52, and 72-77 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2763

DETAILED ACTION

Terminal Disclaimer

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
4. Claims 20-28, 37-39, 42, 50-52 and 72-77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,377,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same scope of the invention.

Art Unit: 2763

Response to Arguments

5. Applicant's remarks regarding double patenting (pages 1-3 of paper 22) are noted, but are not persuasive.

Allowable Subject Matter

6. Claims 20-28, 37-39, 42, 50-52 and 72-77 are allowed over the prior art.
7. The following is an examiner's statement of reasons for allowance (assuming the double patenting rejection is overcome):
- Applicant's arguments regarding the IBM disclosure are persuasive. Essentially, the IBM reference is disclosing the use of a single switch instead of the PIC (programmable interconnect chip) as disclosed by Applicant (pages 3-6 of paper # 22);
 - Applicant's arguments (pages 7-12 of paper # 22) regarding the Kung reference are also persuasive. All present independent claims include a limitation directed at electrically separate conductors which were not present in the Kung reference. The significance of the segmented leads is provided by Applicant beginning on the last paragraph of page 7 through page 9 of paper # 22;
 - an updated search of the literature uncovered the Butts et al. reference which was cited in an earlier office action (U. S. Patent 5,036,473 - of record. See papers # 17 and 20 [pages 5-6]). This reference discloses crossbar chips. However, only the fact that that feature was not disclosed in the parent application re Butts et al. (the '473

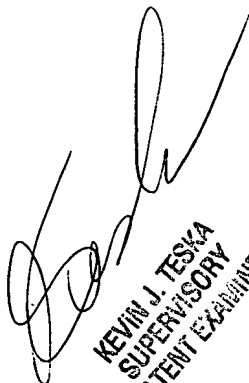
Art Unit: 2763

patent being a CIP) renders that disclosure regarding crossbar chips not applicable as prior art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Hugh Jones whose telephone number is (703) 305-0023.

Dr. Hugh Jones

November 8, 1999



KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER